

Application Serial No. 10/803,264  
Response to November 29, 2004 OA

MI22-2524

### REMARKS

Typographical errors in the specification are corrected.

Claim 32 is amended. New dependent claims 39-41 are added. Support for the new claims is provided by exemplary embodiments of the invention disclosed by the originally-filed application at, for example, page 7.

Claim 32 stands rejected under 35 U.S.C. §112, first and second paragraphs, as failing to comply with the written description requirement and for being indefinite. Claims 31-38 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 31, 33 and 35-37 stand rejected under 35 U.S.C. §102(e) as being anticipated by Leedy, 5,323,035.

Regarding the §112, first and second paragraphs, rejections against claim 32, claim 32 is amended as agreed during the Examiner Interview of February 23, 2005. As discussed in the interview, claim 32 is believed to be allowable.

Regarding the §112 second paragraph rejection against claim 31, the Examiner alleges functional language and "intended use" language is present in claim 31, and that this language makes the claim indefinite. The Examiner presents several arguments for how this language makes the claim indefinite, but these arguments simply are not relevant for a determination of indefiniteness. For example, the Examiner addresses how claims with "intended use" language are to be interpreted over prior art, but this is not the test for indefiniteness as discussed below. During the Examiner Interview of February 23, 2005,

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Applicant's Representative **stressed to the Examiner that** the arguments presented by the Examiner *against claim 31 are not relevant to a determination of indefiniteness* under a §112, second paragraph.

Respectfully, the Examiner is reminded that the MPEP states, "the examiner's focus...for definiteness is...whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available (emphasis added)...[and that threshold is] with a reasonable (emphasis in quote) degree of particularity and definiteness. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) the content of the particular application disclosure;
- (B) the teachings of the prior art; and
- (C) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

In reviewing a claim for compliance with 35 U.S.C. §112, second paragraph, the Examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. §112, second paragraph (citations omitted) MPEP §2173.02 (8th ed. revision no. 2).

In fact, Applicant's Representative reminded the Examiner that the **MPEP specifically states** that if the Examiner merely wants the Applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. §112, second paragraph. MPEP §2173.02 (8<sup>th</sup> ed. revision no. 2) (emphasis in MPEP). Applicant's Representative also pointed out to the

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Examiner that the first sentence of the rejection is directed to the breadth of claim 31, and that the **MPEP clearly states that the breadth of a claim is not to be equated with indefiniteness**. MPEP §2173.04 (8<sup>th</sup> ed. revision no. 2) *citing In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971).

In conclusion regarding the §112 second paragraph rejection against claim 31, Applicant submits that claim 31 is clear and precise, particularly in light of the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art pursuant to the above appropriate determination and test for indefiniteness. The fact that the Examiner has presented a rejection against claim 31 over prior art is evidence that the claim language of claim 31 is definite. Moreover, "[a] fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers [and] [t]hey can define in the claims what they regard as their invention essentially in whatever terms they choose...." MPEP §2173.01 (8th ed. revision no. 2). The claim language of claim 31 is definite, and therefore, the §112 second paragraph rejection against claim 31 is inappropriate and should be withdrawn.

No other rejections are presented against claims 32, 34 and 38, and therefore, such claims are allowable.

Regarding the rejection against claim 31 as being anticipated by Leedy, claim 31 recites an engagement probe comprising semiconductor **bulk** substrate material. Leedy does not teach or suggest a **bulk** substrate. Leedy teaches an insertion structure 10 with a pointed tip 18 covered by a conductive layer 20

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(col. 2, Ins. 18-55) wherein the pointed tip 18 comprises a structural layer 14 of dielectric material, preferably (col. 4, lines 61-68), but could comprise polysilicon (col. 5, lines 1-10). However, the pointed tip formed by the structural layer is formed from material that is deposited (col. 3, ln. 50 through col. 4), and therefore, logically, the pointed tips can not comprise bulk material. In no fair or reasonable interpretation does Leedy teach or suggest an engagement probe comprising semiconductor **bulk** substrate material as positively recited in claim 31. Accordingly, Leedy fails to teach or suggest a positively recited limitation of claim 31, and therefore, claim 31 is allowable.

Claims 32-41 depend from independent claim 31, and therefore, are allowable for the reasons discussed above with respect to the independent claim, as well as for their own recited features which are not shown or taught by the art of record.

This application is now believed to be in immediate condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such subsequent action.

Respectfully submitted,

Dated: 2-28-05By:   
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